

Applicant : Robert H. Walker
Appln. No. : 10/757,898
Page : 4

REMARKS

Claims 1-6 remain present in this application. Claims 1 and 4 have been amended. Support for these amendments can be found throughout the specification, claims, and drawings as originally filed.

In the present Office Action, the Examiner rejected claims 1, 3-4, and 6 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,573,227 to Hemauer et al. (hereinafter "Hemauer"). The Examiner also rejected claims 2 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Hemauer in view of U.S. Patent No. 5,314,167 to Holloman (hereinafter "Holloman"). Applicant respectfully traverses these rejections for the reasons set forth below.

In regard to the rejection of claims 1, 3-4, and 6 under 35 U.S.C. § 102(b) as being anticipated by Hemauer, Applicant respectfully submits that "[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984) (emphasis added). Furthermore, functional language in an apparatus claim requires that the anticipatory reference possess the capability of performing the recited function. *R.A.C.C. Industries Inc. v. Stun-Tech Inc.*, 49 U.S.P.Q.2d 1793 (Fed. Cir. 1998) ("[I]n *Intel Corp. v. U.S. International Trade Commission*, 948 [sic, 946] F.2d 821, 832; 20 U.S.P.Q.2d 1161, 1171 (Fed. Cir. 1991), this court interpreted functional language in an apparatus claim as requiring that an accused apparatus possess the capability of performing the recited function.").

At the outset, Applicant respectfully notes that Hemauer is directed to a stanchion, and that the U-shaped recess of Hemauer does not have two substantially parallel sides which are directly opposite each other. Rather, the U-shaped recess, as defined by Hemauer, has a flange 220, which is not directly opposite bracket arm 240. In addition, Hemauer does not teach a fastening member for securing the U-shaped

recess to the facia board so that the facia board bears the entire weight of the facia guard bracket when the fastening member secures the facia board against one wall of the U-shaped recess. Instead, the bracket of Hemauer is supported largely by the trusses.

In contrast, the present claimed invention utilizes a fastening member that secures the facia board against at least one wall of the U-shaped recess of the facia guard bracket, such that the facia board bears the entire weight of the facia guard bracket in the assembled fall protection device.

In regard to the rejection of claims 2 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Hemauer in view of Holloman, Applicant respectfully submits that the combined references fail to teach or suggest each and every limitation of the rejected claims. In order to establish a *prima facie* case of obviousness, three criteria must be met. M.P.E.P. § 706.02(j). Firstly, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference, or to combine reference teachings. *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Secondly, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Thirdly, the prior art reference (or references) must teach or suggest all the claim limitations. *In re Royka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Hedges*, 783 F.2d 1038, 1041; 228 U.S.P.Q. 685, 687 (Fed. Cir. 1986).

Holloman discloses a rail structure for a floor, not a roof. Indeed, the Holloman structure cannot realistically be used on a pitched roof, due to the shape of the device. In addition, the Holloman device has absolutely no bearing on roofs, because the structure cannot be used with roofs, due to the fact that a hole would need to be placed in the roof, and the fact that it is not configured to be utilized with a pitched floor, let alone a pitched roof. Also, the U-shaped yokes are designed such that the portion of the U-shaped yoke that connects the two substantially parallel opposing sides bears the weight of the device onto the top of the band of the floor. (See Fig. 3).

In addition, one skilled in the art would not have considered using the bolt of Holloman to secure the flange of Hemauer to a fascia board since such bolt would then bear part of the weight of the bracket, whereas in Holloman, the bolt does not bear the weight of the bracket.

Because the references alone, or in combination, fail to teach or suggest each and every limitation of claims 2 and 5, the rejection of claims 2 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Hemauer in view of Holloman is improper and should be withdrawn, which action is respectfully requested.

By way of the foregoing discussion, Applicant has demonstrated that the pending claims are not anticipated by Hemauer, and would not have been rendered obvious in view of Hemauer, in combination with Holloman. Accordingly, the rejections of claims 1-6 under 35 U.S.C. §§ 102(b) and 103(a) should be withdrawn, which action is respectfully requested.

Applicant respectfully submits that this Amendment and Reply are fully responsive to the above-referenced Office Action, and that the claims are in condition for allowance, such allowance being respectfully requested.

Applicant : Robert H. Walker
Appln. No. : 10/757,898
Page : 7

CONCLUSION

For all of the foregoing reasons, Applicant respectfully submits that claims 1-6 are in condition for allowance, which action is respectfully requested. If the Examiner has any questions or comments with respect to this Reply, the Examiner is encouraged to contact the undersigned at 616/949-9610.

Respectfully submitted,

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